

06-24-03.

Express Mail No.: EV33585583US

RECEIVED  
JUN 26 2003  
TECH CENTER 180012800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Robarge et al.

Confirmation No. 6358

Application No.: 10/032,286

Group Art Unit: 1625

Filed: December 21, 2001

Examiner: Chang, Celia C.

For: ISOINDOLE-IMIDE COMPOUNDS,  
COMPOSITIONS, AND USES  
THEREOF

Attorney Docket No.: 9516-0048-999

INFORMATION DISCLOSURE STATEMENT  
UNDER 37 C.F.R. § 1.56 AND § 1.97

Assistant Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

SIR:

In accordance with the duty of disclosure imposed by 37 C.F.R. § 1.56 and § 1.97 to inform the Patent and Trademark Office of all references coming to the attention of each individual associated with the filing or prosecution of the subject application, which are or may be material to the patentability of any claim of the application, Attorneys for Applicants hereby direct the Examiner's attention to references AA-CN listed on the attached revised form PTO 1449 entitled "List of References Cited by Applicants." The instant application is a continuation of patent application Serial No. 09/972,487, filed October 5, 2001. References AA through CC on the attached revised form PTO 1449 were cited by or submitted to the Patent Office in connection with patent application Serial No. 09/972,487, to which the instant application claims priority pursuant to 35 U.S.C. § 120. Pursuant to 37 C.F.R. § 1.98(d), the Examiner is directed to the file of application Serial No. 09/972,487 for copies of references AA-CC; however, if the examiner requests copies of the cited references, legible copies will be provided. Copies of the references CD to CN are submitted herewith. Applicant respectfully requests that the Examiner review the foregoing references and that the references be made of record in the file history of the application.

This Information Disclosure Statement is being filed after the mailing date of the first Office Action on the merits and before the mailing of final Office Action or a Notice of Allowance. Accordingly, a fee of **\$180.00**, as specified by 37 C.F.R. §1.17(p), is believed to be required for this submission. Please charge the required fee to Pennie & EdmondsLLP Deposit Account No. 16-1150. A copy of this sheet of this is enclosed for accounting purposes.

Respectfully submitted,

Date June 23, 2003

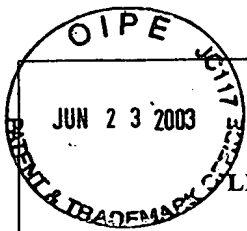
*Anthony M. Insogna* 35203

Anthony M. Insogna (Reg. No.)

**PENNIE & EDMONDS** LLP  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

Enclosure

*By: Nicholas D. Cash*  
Reg No. 51,615



Express Mail No. EV335855683US

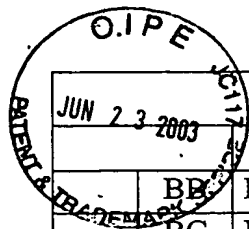
ATTY. DOCKET NO. 9516-0048-999	APPLICATION NO. 10/032,286
APPLICANT Robarge et al.	
FILING DATE December 21, 2001	GROUP 1625

LIST OF REFERENCES CITED BY APPLICANT  
(Use several sheets if necessary)

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	AA	3,992,189	11/16/76	Goddard			
	AB	5,045,108	9/3/91	Elbe et al.			
	AC	5,198,402	3/30/93	Kaji et al.			
	AD	5,326,800	7/5/94	Horn et al.			
	AE	5,385,901	1/31/95	Kaplan et al.			
	AF	5,605,914	2/25/97	Muller			
	AG	5,635,517	6/3/97	Muller et al.			
	AH	5,658,940	8/19/97	Muller et al.			
	AI	5,698,579	12/16/97	Muller			
	AJ	5,703,098	12/30/97	Muller et al.			
	AK	5,728,845	3/17/98	Muller et al.			
	AL	5,736,570	4/7/98	Muller et al.			
	AM	5,798,368	8/25/98	Muller et al.			
	AN	5,801,195	9/1/98	Muller et al.			
	AO	5,874,448	2/23/99	Muller et al.			
	AP	5,877,200	3/2/99	Muller			
	AQ	5,929,117	7/27/99	Muller et al.			
	AR	5,955,476	9/21/99	Muller et al.			
	AS	5,968,945	10/19/99	Muller et al.			
	AT	6,011,050	1/4/00	Muller et al.			
	AU	6,020,358	2/1/00	Muller et al.			
	AV	6,046,221	4/4/00	Muller et al.			
	AW	6,075,041	6/13/00	Muller			
	AX	6,130,226	10/10/00	Muller et al.			
	AY	6,180,644	1/30/01	Muller et al.			
	AZ	6,200,987	3/13/01	Muller			
	BA	6,214,857	4/10/01	Muller et al.			

RECEIVED  
 JUN 25 2003  
 TECH CENTER 1600/2400



# **FOREIGN PATENT DOCUMENTS**

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	BB	EP 0 797 437	10/1/97	Europe				
	BC	EP 1 004 572	5/31/00	Europe				
	BD	EP 1 004 580	5/31/00	Europe				
	BE	EP 1 004 581	5/31/00	Europe				
	BF	WO 00/25777	5/11/00	PCT				
	BG	WO 00/38521	7/6/00	PCT				
	BH	WO 00/55134	9/21/00	PCT				
	BI	WO 92/18496	10/29/92	PCT				
	BJ	WO 95/01348	1/12/95	PCT				
	BK	WO 96/20705	7/11/96	PCT				
	BL	WO 96/20926	7/11/96	PCT				
	BM	WO 97/08143	3/6/97	PCT				
	BN	WO 97/12859	4/10/97	PCT				
	BO	WO 97/23457	7/3/97	PCT				
	BP	WO 97/37988	10/16/97	PCT				
	BQ	WO 98/03502	1/29/98	PCT				
	BR	WO 98/06692	2/19/98	PCT				
	BS	WO 98/24763	6/11/98	PCT				
	BT	WO 98/41525	9/24/98	PCT				
	BU	WO 98/54170	12/3/98	PCT				
	BV	WO 99/06041	2/11/99	PCT				
	BW	WO 99/46258	9/16/99	PCT				
	BX	WO 99/47512	9/23/99	PCT				

**RECEIVED**  
 JUN 26 2003  
 TECH CENTER 1600/2600

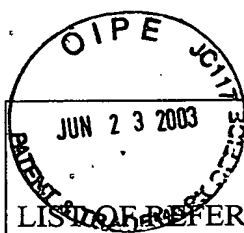
## **OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)**

BY	Corral et al., 1999, "Differential cytokine modulation and T cell activation by two distinct classes of thalidomide analogues that are potent inhibitors of TNF- $\alpha$ ", J Immunol. 163:380-386
BZ	He et al., 1993, "Synthesis of thalidomide analogs and their biological potential for treatment of graft versus host disease", Abstracts of Papers, 206 <sup>th</sup> ACS National Meeting, Abstract No. 216
CA	Muller et al., 1996, "Structural modifications of thalidomide produce analogs with enhanced tumor necrosis factor inhibitory activity", J. Med. Chem. 39:3238-3240
CB	Muller et al., 1998, "Thalidomide analogs and PDE4 inhibition" Bioorg. Med. Chem. Lett. 8:2669-2674
CC	Muller et al., 1999, "Amino-substituted thalidomide analogs: potent inhibitors of TNF- $\alpha$ production", Bioorg. Med. Chem. Lett. 9:1625-1630

**EXAMINER**

**DATE CONSIDERED**

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



**LIST OF REFERENCES CITED BY APPLICANT**  
(Use several sheets if necessary)

ATTY DOCKET NO.  
9516-0048-999

APPLICATION NO  
10/032,286

APPLICANT  
Robarge *et al.*

FILING DATE  
December 21, 2001

GROUP  
1625

**U.S. PATENT DOCUMENTS**

*EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
CD	3,992,189	11/16/76	Goddard			

**FOREIGN PATENT DOCUMENTS**

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
					YES NO
CE WO 97/45117	12/4/97	PCT			

**OTHER REFERENCES** (Including Author, Title, Date, Pertinent Pages, Etc.)

CF	Bundgaard, "Design of prodrugs" Elsevier, Amsterdam - New York - Oxford, p.27-43 (1986).
CG	Corral et al., 1996, "Selection of novel analogs of thalidomide with enhanced tumor necrosis factor alpha inhibitory activity" Mol. Med. Jul;2(4):506-15
CH	Database CAPLUS on STN (Columbus, OH, USA), No. 118:131893, 'The hydrolysis of azidoprofen esters: a model for a soft anti-inflammatory drug for topical application' Int. J. Phar. Vol. 89, p. 65-74 (1993), abstract.
CI	Database CAPLUS on STN (Columbus, OH, USA), No. 128:140615, 'Substituted 2-(2,6-dioxo-3-piperidiny)phthalimides and 1-oxoisindolines and method of reducing TNF-alpha levels' WO98/03502, abstract and registry no. 191732-76-0, 202271-87-2, 202271-88-3, 202271-89-4, 202271-90-7.
CJ	Database CAPLUS on STN (Columbus, OH, USA), No. 130:38290, 'Substituted 2-(2,6-dioxo-3-piperidiny)phthalimides and 1-oxoisindolines and method of reducing TNF-alpha levels' WO98/54170, abstract and registry no. 202271-88-3, 216669-27-1, 191732-72-6.
CK	Database CAPLUS on STN (Columbus, OH, USA), No. 131:214197, 'Preparation of 2-(2,6-dioxo-3-fluoropiperidin-3-yl) isoindolines for reducing inflammatory cytokine levels' US 5,955,476, abstract and registry no. 220460-56-0, 220460-57-1, 220460-62-8, 220460-64-0.
CL	Marriott et al., 2001, "Immunotherapeutic and antitumor potential of thalidomide analogue" Expert Opin. Biol. Ther. Jul;1(4):675-82. Review
CM	Miyachi et al. 1998, "Tumor necrosis factor-alpha production enhancing activity of substituted 3'-methylthalidomide: influence of substituents at the phthaloyl moiety on the activity and stereoselectivity" Chem. Pharm. Bull. (Tokyo). Jul;46(7):1165-8.
CN	Price et al., 2002, "5'-OH-thalidomide, a metabolite of thalidomide, inhibits angiogenesis" Ther. Drug monit. Feb;24(1):104-10.

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.